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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,414	11/09/2001	Rick Korczak	7836/83306	2098

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EXAMINER
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MARSH, STEVEN M

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/046,414

Applicant(s)

KORCZAK ET AL.

Examiner

Steven M Marsh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 100 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9,10,14,15.                      6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1-6,8-26,29-32,34,36,37,39-42,49,73-75,78,82,94,95,97-100,108-112,121-126,128,134 and 141.

Continuation of Disposition of Claims: Claims rejected are 1-6,8-26,29-32,34,36,37,39-42,49,73-75,78,82,94,95,97-99,108-112,121-126,128,134 and 141.

### **DETAILED ACTION**

This is the second office action for U.S. Application 10/046,414 for an Anchor Rail Adapter and Hanger Method filed by Korezak et al. on November 9, 2001. Claims 7, 27, 28, 33, 35, 38, 43-48, 50-59, 61-72, 76, 77, 79-81, 83-93, 96, 101-107, 113-120, 127, and 135-140 have been canceled.

### ***Drawings***

The drawings were received on March 31, 2003. These drawings are acceptable.

### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on January 13, 2003, April 23, 2003, and June 12, 2003 were filed after the mailing date of the Non-final rejection on December 5, 2002. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

Claims 1, 14, 24, 73, and 94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant does not claim an anchor rail or a channel in the claims, but recites limitations that define both. The

combination is not claimed and therefore the claims are interpreted as being towards a hanger capable of performing the function in the preamble.

### ***Double Patenting***

Claims 1-6, 8-10, 14-17, 23-26, 29, 34, 36, 37, 39-42, 49, 73-75, 78, 82, 94, 95, 97, 108, 109, 121-126, 128-134, and 141 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7-12, 14-26, and 28-38 of U.S. Patent No. 6,354,543. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structure of the hanger and the method of use is the same in both the application and the patent. The structure of the hanger includes the legs, a mounting surface with an opening, barbed feet, spring fingers to retain the pipe or line and allow for different diameters, and resiliency to allow the legs to be squeezed together to insert the feet into the hole of another hanger or object. The hangers are also stackable.

Claims 1-6, 8-10, 14-17, 23-26, 29, 34, 36, 37, 39-42, 49, 73-75, 78, 82, 94, 95, 97, 108, 109, 121-126, 128-134, and 141 are directed to an invention not patentably distinct from claims 1-5, 7-12, 14-26, and 28-38 of U.S. Patent No. 6,354,543. Specifically, both the application and the patent claim a flexible hanger with mounting legs and an opening on the mounting surface that allows two or more hangers to be stacked and the method to use the hanger.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP

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2302). Commonly assigned U.S. Patent No. 6,354,543 B1, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

### ***Claim Rejections - 35 USC § 102***

Claims 1-6, 8-10, 14-17, 20-26, 29, 34, 36, 37, 39-42, 49, 73-75, 78, 82, 94, 95, 97, 108, 109, 121-126, 128-134, and 141 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. All of the subject matter claimed in these claims was already disclosed and taught in the '543 patent to Paske.

Claims 1, 2, 7-9, and 141 are rejected under 35 U.S.C. 102(b) as being anticipated by Kreinberg et al. Kreinberg et al. discloses an adapter comprising a mounting surface (48), flanges depending from the mounting surface, and mounting

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legs extending from the flanges. The mounting legs each have a hook-like portion (26) extending substantially along the width of the of the mounting leg and the adapter is flexible to permit urging of the flanges inwardly toward one another. The mounting legs include an inwardly extending portion contiguous with a downwardly extending portion, wherein the hook-like portion is formed at an end of the downwardly extending portion. An opening (56) is formed in the mounting surface, which is the top, planar surface.

***Claim Rejections - 35 USC § 103***

Claims 1-6, 8-10, 14-17, 20-26, 29, 34, 36, 37, 39-42, 49, 73-75, 78, 82, 94, 95, 97, 108, 109, 121-126, 128-134, and 141 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '543 patent to Paske.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer

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in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Paske shows an adapter (10) comprising a mounting surface, flanges depending from the mounting surface, and opposed mounting legs with feet, the legs extending from the flanges, and the feet each having a hook-like portions (22) which prevent slippage, the adapter being flexible to permit urging the flanges inwardly toward one another and further being resilient. The mounting legs include an inwardly extending portion contiguous with a downwardly extending portion, and wherein the hook-like portion is formed at the end of the downwardly extending portion. There is at least one binding element (projection tabs on either side of 14 and 16) formed on at least one of the mounting legs cooperating with each hook-like portion to clamp the object that it is mounted to between the hook-like portion and the binding element. The binding element is a tab disposed on the inwardly extending portion and is defined by a pair of notches in the inwardly extending portion. The tab includes a downwardly bent portion. Means for mounting include frictional means and an opening (108), formed on the mounting surface, which is a planar top surface. There is also a plurality of downwardly/inwardly-oriented projections (114) included in the mounting means, which extend from a periphery of the opening. A different embodiment shows the mounting surface can also be curved as shown in Figure 10a. There are slots formed in the



flanges (behind spring members "30"). An opening in the mounting surface allows other hangers or articles to be attached and allows stacking to permit a number of articles to daisy-chained. The adapter (10) supports an article between its legs, traverse to the legs, and is able to support articles of different diameters and different types. There are spring fingers (29 and 30), which allow for the different diameters. The feet (22) are configured so that the legs are automatically pinched when pushed into an opening and snap into the opening because of the legs resiliency. There are four legs with two legs positioned on each side of the article. Regarding claims 73-81, 84-89, and 92-92 the "support" and the "adapter" are virtually the same thing since the structures are similar and the claim language reads on the same structure for both. Since the adapter is stackable as shown in Figure 5 by Paske, the bottom hanger is the "adapter" and the upper hanger is the "support". Both are shown to be of a generally U-shaped resilient configuration. Vibrations of the held articles are dampened.

Claims 11, 12, 18, 19, 30, 31, 98, 99, and 110-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paske (6,354,543 B1) in view of Heath (5,344,108). Paske shows all features claimed by the Applicant's invention, but does not show a collar with threads depending from the opening. Heath shows a circular opening on the top surface of a hanger, which comprises a threaded collar (34b). It would have been obvious to one of ordinary skill in the art at the time of the present invention to have replaced the square opening of Paske, with the circular opening with a threaded collar as taught by Heath, for the purpose of allowing different connectors to be attached to the hanger that requires threading.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreinberg in view of Heath (5,344,108). Kreinberg does not disclose a collar with threads depending from the opening. Heath discloses an opening on the top surface of a hanger, which comprises a threaded collar, as discussed above. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have included a threaded collar on the hanger taught by Kreinberg, as taught by Heath, for the purpose of strengthening and protecting the opening taught by Kreinberg.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kreinberg in view of Andre (4,505,006). Kreinberg does not disclose radial friction tabs. Radial friction tabs are well known in the art to be used to grip an object and provide enough of a resiliency to hold it in place. Andre shows radial friction tabs (12) for holding an article in place. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have included radial friction tabs on the hanger taught by Kreinberg, as taught by Andre, for the purpose of providing an alternate means of connection.

Claims 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paske (6,354,543 B1) in view of Andre (4,505,006). Paske does not disclose radial friction tabs. Radial friction tabs are well known in the art to be used to grip an object and provide enough of a resiliency to hold it in place. Andre shows radial friction tabs (12) for holding an article in place. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have included radial friction tabs on the hanger

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taught by Paske, as taught by Andre, for the purpose of providing an alternate means of connection.

***Allowable Subject Matter***

Claim 100 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed March 31, 2003 have been fully considered but they are not persuasive. In response to applicant's arguments, the recitation of a hanger attached to a U-shaped channel or anchor rail has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The hanger taught by the '543 patent is capable of being mounted to a U-shaped channel via the hooks at the bottom.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Marsh whose telephone number is (703) 305-0098. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30 PM. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone

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number is (703) 308-2168. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

  
Steven M. Marsh

November 13, 2003

  
ANITA KING  
PRIMARY EXAMINER